



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/327,408	06/07/1999	PATRICK M. COX	8897-0046-99	5392

7590 05/19/2004

ALEX L. YIP
KAYE SCHOLER LLP
425 PARK AVENUE
NEW YORK, NY 10022

EXAMINER

KNOWLIN, THJUAN P

ART UNIT	PAPER NUMBER
----------	--------------

2642

24

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/327,408

Applicant(s)

COX ET AL.

Examiner

Thjuan P Knowlin

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 158-183 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 158-183 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 158-183 are rejected under 35 U.S.C. 102(e) as being anticipated by Fuller et al (US 5,752,191).
2. In regards to claims 158, 172, 173, and 175, Fuller discloses a method for providing directory assistance to a caller comprising: locating a destination telephone number associated with a desired party; initiating a telephone call between the caller and the desired party (col. 12-13 lines 64-4); determining if a predefined condition relating to the status of the telephone call occurs; and if the predefined condition occurs, obtaining an identifier of a messaging device associated with the desired party for contacting the desired party, the identifier being different from the destination telephone number; and sending a message by the caller to the messaging device associated with the desired party based on the identifier (col. 13 lines 15-19).
3. In regards to claim 159, Fuller discloses the method, wherein the message comprises a voice message (col. 13 lines 18-19).

4. In regards to claims 160 and 176, Fuller discloses the method, wherein the message comprises a text message (col. 14 lines 33-54).
5. In regards to claim 161, Fuller discloses the method, wherein the text message comprises a custom text message (col. 14 lines 33-54).
6. In regards to claim 162, Fuller discloses the method, wherein the custom text message is dictated by the caller to a directory assistance provider (col. 13 lines 4-14 and col. 14 lines 33-54).
7. In regards to claims 163, 170, 180, and 181, Fuller discloses the method, wherein the message comprises a page (col. 13 lines 4-24).
8. In regards to claims 164, 165, and 166, Fuller discloses the method, wherein the predefined condition comprises a non-answering desired party condition (col. 13 lines 22-29 and col. 14 lines 14-31).
9. In regards to claim 167, Fuller discloses the method, wherein an option to have the message sent is offered to the caller after an occurrence of the non-answering desired party condition (col. 14 lines 14-54).
10. In regards to claims 168 and 174, Fuller discloses the method, wherein the message is sent to the desired party after an occurrence of the predefined condition when it is determined that the desired party has the messaging device capable of accepting the message (col. 13 lines 4-19).
11. In regards to claim 169, Fuller discloses the method, wherein the predefined condition comprises call termination (col. 13 lines 18-19).

Art Unit: 2642

12. In regards to claims 171 and 182, Fuller discloses the method, wherein the messaging device comprises a personal communications service (PCS) device (col. 13 lines 4-24).

13. In regards to claims 177 and 179, Fuller discloses the method, wherein the contact information comprises a telephone number associated with the desired party (col. 13 lines 10-18).

14. In regards to claim 178, Fuller discloses the method, wherein the contact information comprises a name of the desired party (col. 13 lines 10-18).

15. In regards to claim 183, Fuller discloses the method, wherein the device comprises a wireless telephone (cellular telephone 20 and col. 13 lines 24-29).

Response to Arguments

16. Applicant's arguments with respect to claims 158-183 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dowden et al (US 5,163,083) teach an automation of telephone operator assistance calls. Wolff et al (US 5,327,486) teach a method and system for managing telecommunications such as telephone calls.

Art Unit: 2642

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thjuan P Knowlin whose telephone number is (703) 308-1727. The examiner can normally be reached on Mon-Fri 8:00-4:30pm.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (703)305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thjuan P. Knowlin
May 17, 2004



AHMAD F. MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700